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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : **MICHAEL E. CARROLL**   CONFIRMATION NO. :   7836

SERIAL NUMBER : 09/450,558   EXAMINER :   Charles Bieneman

FILING DATE : November 30, 1999   ART UNIT :   2176

FOR : **SYSTEM AND METHOD FOR MANAGING DOCUMENTS HAVING FORMULA BASED DOCUMENT LINKS**

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Appellants' Brief On Appeal Under 37 C.F.R. §1.192

Sir:

Further to the Notice of Appeal filed on December 22, 2003, Appellants' herewith submit Appellants' Brief on Appeal in triplicate pursuant to 37 C.F.R. §1.192(a).

It is not believed that extensions of time or fees are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-0311 (*Ref. No. 23452-075*).

(1) REAL PARTY IN INTEREST

By virtue of the assignment recorded November 30, 1999 at reel 010424, frame 0556, the real party in interest is **International Business Machines** Corporation, a New York corporation having a place of business in Armonk, New York.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

(3) STATUS OF THE CLAIMS

Claims 1-61 are pending in the case. Claims 17-21 and 39-43 have been rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 17-21 and 39-43 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 2, 6, 7, 11, 14, 22-26, 29, 30, 33-35, 37, 38, 44-48, 51, 52, 55-57, and 59-60 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Number 5,987,480 issued to Donohue et al. ("Donohue"). Claims 3, 8, 12, and 15 have been rejected under 35 U.S.C. §103(a) as allegedly obvious over Donohue in view of U.S. Patent Number 6,226,648 B1 to Appleman et al. ("Appleman"). Claims 4, 9, and 13, have been rejected under 35 U.S.C. §103(a) as allegedly obvious over Donohue and Appleman and further in view of U.S. Patent Number 6,006,242 to Poole et al. ("Poole"). Claims 5, 10, 32, and 54 have been rejected under 35 U.S.C. §103(a) as allegedly obvious over Donohue in view of World Wide Web Consortium, *HTML 3.2 Reference Specification,* W3C Recommendation 14 January 1997, pages 1-7 ("HTML 3.2") and Appleman. Claim 16 has been rejected under 35 U.S.C. §103(a) as allegedly obvious over Donohue in view of Poole. Claims 17, 36, 39, 58, and 61 have been rejected under 35 U.S.C. §103(a) as allegedly obvious over Donohue in view of U.S. Patent Number 6,442,651 B2 to Crow et al. ("Crow"). Claims 27, 28, 31, 49, 50,

and 53 have been rejected under 35 U.S.C. §103(a) as allegedly obvious over
Donohue in view of Cate Richards, *Using Lotus Notes 4.5* (Que: 1997), Page 9
("Richards").

Appellants appeal the rejections of claims 1-61.

(4) STATUS OF AMENDMENTS

Appellants' amendment to claims 34, 56, and 61 dated November 26,
2003 in response to the Final Office Action dated August 28, 2003 was not
entered by the Examiner. However, contrary to the Examiner's assessment on
the Advisory Action, Appellants submit that these amendments do place the
application in better form for appeal as set forth below.

(5) SUMMARY OF THE INVENTION

The invention relates to a system, method and computer readable
medium that permits a main document to include a reference to an insert
document. In some embodiments, each time the main document is opened, the
reference is used to retrieve the insert document and incorporate the contents of
the insert document in the main document for use. The insert document may be
stored on a shared resource database that may be accessed by multiple
systems. The main document does not store the contents of the insert document
itself and therefore the amount of disk space required to save the document is
reduced. *See* specification at page 3, lines 8-16.

The reference to the main document may include a formula that
determines which of a plurality of insert documents is to be included in the main
document. Accordingly, the main document may be dynamically changed to
include different insert documents depending on the results of the formula. In
some embodiments of the invention, the formula may be resolved continuously
so that the insert document included within the main document may change even
while the document is opened and in use. Once resolved from the formula, the

reference is used to determine the insert document to be retrieved. *See* specification at page 4, lines 1-4 and 8-10, page 13, lines 4-5.

(6) ISSUES

1. Whether Appellants' after final amendment would have put the application in better form for appeal.

2. Whether claims 17-21 and 39-43 are unpatentable, under 35 U.S.C. §112, first paragraph, as not enabled.

3. Whether claims are 17-21 and 39-43 are unpatentable, under 35 U.S.C. §112, second paragraph, as being indefinite.

4. Whether claims 1, 2, 6, 7, 11, 14, 22-26, 29, 30, 33-35, 37, 38, 44-48, 51, 52, 55-57, 59, and 60 are unpatentable, under 35 U.S.C. §102(e) as anticipated by Donohue.

5. Whether claims 3, 8, 12, and 15 are unpatentable, under 35 U.S.C. §103(a) as obvious from Donohue in view of Appleman.

6. Whether claims 4, 9, and 13 are unpatentable, under 35 U.S.C. §103(a) as obvious from Donohue and Appleman and further in view of Poole.

7. Whether claims 5, 10, 32, and 54 are unpatentable, under 35 U.S.C. §103(a) as obvious from Donohue in view of HTML 3.2 and Appleman.

8. Whether Claim 16 is unpatentable, under 35 U.S.C. §103(a) as obvious from Donohue in view of Poole.

9. Whether claims 17, 36, 39, 58, and 61 are unpatentable, under 35 U.S.C. §103(a) as obvious from Donohue in view of Crow.

10. Whether claims 27, 28, 31, 49, 50, and 53 are unpatentable, under 35 U.S.C. §103(a) as obvious from Donohue in view of Richards.

(7) GROUPING OF CLAIMS

Claims 1-61 are separately patentable. However, Appellants have grouped claims that include similar features. In particular, Appellants request that claims 1, 5, 6, 10, 11, and 14 be considered to stand and fall together; that claim 61 be considered to stand and fall alone, that claims 2 and 7 be considered to stand and fall together, that claims 3, 8, 12, and 15 be considered to stand and fall together, that claims 4, 9, and 13 be considered to stand and fall together, that claim 16 stand and fall alone, that claims 17 and 39 be considered to stand and fall together, that claims 18-21 and 40-43 stand and fall together, that claims 22 and 44 stand and fall together, that claims 23 and 45 be considered to stand and fall together, that claims 24 and 46 be considered to stand and fall together, that claims 25 and 47 be considered to stand and fall together, that claims 26 and 48 stand and fall together, that claims 32 and 54 stand and fall together, that claims 34 and 56 stand and fall together, that claims 37 and 59 stand and fall together, that claims 27, 28, 49, and 50 be considered to stand and fall together, that claims 29, 30, 51, and 52 be considered to stand and fall together, that claims 31 and 53 be considered to stand and fall together, that claims 33 and 55 be considered to stand and fall together, that claims 35 and 57 be considered to stand and fall together, that claims 36 and 58 be considered to stand and fall together, and that claims 38 and 60 be considered to stand and fall together.

(8) ARGUMENT

For issue 1, the question to be resolved is whether Appellants' after final amendment would have placed the application in better form for appeal. Appellants respectfully submit that the denial of entry was improper, because the amendment simplified the issues for appeal.

For issue 2, the question to be resolved is whether the claim term "continuously" is enabled by the specification. Appellants respectfully submit that the claimed feature "continuously" is enabled by the specification, because the specification includes sufficient disclosure to enable one of ordinary skill in the art

to make and use the invention including the feature of resolving the formula "continuously."

For issue 3, the question to be resolved is whether the claim term "continuously" renders the claim indefinite. Appellants respectfully submit that the use of "continuously" does not render the claim indefinite, because one of ordinary skill in the art would understand the meaning of the word "continuously" in light of Appellants' specification.

For issue 4, the question to be resolved is whether Donohue anticipates claims 1, 2, 6, 7, 11, 14, 22-26, 29, 30, 33-35, 37, 38, 44-48, 51, 52, 55-57, 59, and 60, under 35 U.S.C §102(e). Appellants respectfully submit that the claims are patentable, because Donohue does not disclose all the claim elements. Appellants provide below a discussion of the requirements for anticipation under 35 U.S.C. §102(e) and an application of these requirements to each rejected claim.

For issues 5-10, the question to be resolved is whether the Examiner set forth a *prima facie* case of obviousness as required by 35 U.S.C. §103(a). Appellants respectfully submit that the Examiner failed to set forth a *prima facie* case for at least failing to teach or suggest the claim elements and because proper motivation to combine the references has not been provided. Appellants provide below a discussion of the requirements for a *prima facie* case of obviousness under 35 U.S.C. §103(a) and an application of these requirements to each rejected claim.

1. Non-entry Of After Final Amendment -

The Examiner denied entry of Appellants' after final amendment filed November 26, 2003, because it would "raise new issues that would require further consideration and/or search"; and "they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal." (*See* Box 2(a) and 2(d) of the Advisory Action). Appellants submit that this decision was improper for the following reasons.

With regards to amendments to claims 34 and 56, Appellants amended the claims provide antecedent basis. The article "a" was inserted before the word "combination." These amendments clearly removed an issue for appeal.

With respect to claim 61, in the Final Office Action dated August 28, 2003, Examiner stated:

> "Note that the examiner does not regard the clauses beginning with the words 'in order to' in this claim to further limit the scope of the claim because the clauses merely recite an effect of implementing the recited method step element but do not further limit or define the step or element being recited." (*See* page 13, first full paragraph of the Final Office Action).

Apparently, the Examiner is relying on the language "in order to" to ignore certain features of the claim. In an effort to expedite prosecution, Appellants amended claim 61 to more positively recite these features previously ignored by the Examiner. Furthermore, this amendment merely recast the language previously presented in the claims that the Examiner previously elected to ignore. Thus, the amendment simplified the issues presented for appeal.

"The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues for appeal are simplified." *See* M.P.E.P. 714.13.

For the foregoing reasons, Appellants submit that the Examiner's denial of entry of the after final amendment was improper. Accordingly, claim 61 as amended will be addressed in this appeal.

2. Rejection Under 35 U.S.C. §112, First Paragraph -

Dependent claims 17-21 and 39-43 have been rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. Appellants respectfully submit that this rejection is improper for the following reasons.

The Examiner asserts that the specification does not explain how a formula would be resolved continuously (*See* page 3, lines 3-4 of the Final Office Action). The Examiner further alleges that it would have been impossible truly to resolve the formula "continuously" under the plain and ordinary meaning of that word in as much as resolving the formula was inherently discrete act (*See* page 3, lines 15-17 of the Final Office Action). Appellants submit that "continuously" performing an operation, function, or other act in the context of computer software applications would be well within the vernacular and understanding of one of ordinary skill in the art. Hence, the specification at page 4, lines 6-10, and page 17, line 17 through page 18, line 6 provides sufficient disclosure so as to enable one skilled in the art to make and use the invention. For at least these reasons, the rejection of claims 17-21 and 39-43 under 35 U.S.C. § 112, first paragraph is improper and must be withdrawn.

3. <u>Rejection Under 35 U.S.C. §112, Second Paragraph</u> -

Dependent claims 17-21 and 39-43 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Appellants respectfully submit that this rejection is improper for the following reasons.

The Examiner alleges that it would have been impossible truly to resolve the formula "continuously" under the plain and ordinary meaning of that word in as much as resolving the formula was inherently discrete act (*See* page 3, lines 15-17 of the Final Office Action). Appellants submit that "continuously" performing an operation, function, or other action in the context of computer software applications would be well within the vernacular and understanding of one of ordinary skill in the art. Hence, the use of the term "continuously" in the claims is definite and the rejection of claims 17-21 and 39-43 must be withdrawn.

4. Rejection Under 35 U.S.C. §102(e) Over Donohue -

Requirements for anticipation

As stated in the MPEP § 2131, a claim is anticipated only if each element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claims 1, 6, 11, and 14 and dependent claims 5, and 10

Appellants respectfully submit that the rejection of claims 1, 2, 6, 7, 11, 14, 22-26, 29, 30, 33-35, 37, 38, 44-48, 51, 52, 55-57, 59, and 60 under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue is improper for at least failing to disclose all the claim elements.

Claim 1 includes, *inter alia*, the features of "the main document with a formula that resolves to a reference to an insert document, the insert document including contents for the main document" and "a document insertion module that inserts the insert document into the main document." At least these features are not disclosed by Donohue.

Apparently, the Examiner relies on the descriptions in Donohue that disclose inserting stored textual contents such as name, user-ID, order-ID, total-due, etc., into a web-based template using dynamic HTML content tags. This description has been reproduced below for convenience:

> ...into the markup language document dynamic flow directives comprising one or more second control symbols, one or more if or loop instructions...

> Alternatively, the data source 12 may be stored on another computer to which the web server 10 has access. In some embodiments, the data source is a relational database and includes a database storing content to be inserted into the templates 24...

> For a dynamic tag, the template user 18 calls the appropriate library function 22 to retrieve the value corresponding to the name in the tag from

the container, step 62, and replace the dynamic tag, including the name and control symbols, with the value retrieved from the container, step 64.... (*See* col. 6, lines 10-13, col. 7, lines 37-41, and col. 10, lines 60-65 of Donohue).

Inserting textual data is not the same as inserting a document that includes the data. The Examiner asserts that the specification broadly defines "insert document," stating that term "should be understood to include data that may inserted into a main document," and therefore the data falls within the definition of "insert document" (*See* page 14, lines 14-16 of the Final Office Action). This interpretation of insert document by the Examiner is improper because the insert document is not data *per se*. The specification indicates that the insert document includes data (*See* specification, page 7, lines 4-5). A document that includes data is not the same as data itself.

Accordingly, Donohue does not disclose inserting the insert document into the main document as set forth in claim 1. For at least this reason, Appellants respectfully submit that claim 1 is patentable over Donohue. Independent claims 6, 11, and 14 recite features similar to those discussed above with regard to claim 1. Therefore, independent claims 6, 11, and 14 are also patentable for at least the reasons set forth above for claim 1.

Dependent claims 2 and 7

Claims 2 and 7 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 2 and 7 are also patentable at least by virtue of their dependency.

Furthermore, claim 2 recites, *inter alia,* "a document identification module that receives a reference and determines the name of the insert document to be retrieved based on the reference." Claim 7 recites similar features to claim 2. These features are not disclosed by Donohue.

The Examiner maintains the position that Donohue teaches the features of claim 2 and 7 "inasmuch as Donohue et al. teaches retrieving 'the value corresponding to the name in the tag from the container. (Donohue et al., col. 10, lines 61-62.)'." (*See* page 6, 2d full paragraph of the Final Office Action).

Donohue col. 10, lines 61-62 recites:

> For a dynamic tag, the template parser 18 calls the appropriate library function 22 to retrieve the value corresponding to the name in the tag from the container...

Appellant submits that Donohue merely discloses using a dynamic name tag to obtain a value. The claimed invention recites "receives a reference and determines the name of the insert document to be retrieved." The Examiner is equating Donohue's name tag with Appellants' reference and Donohue's value with Appellants' name of the insert document. This interpretation is inconsistent with Appellants' claim language. For at least this additional reason, Appellants submit that claims 2 and 7 are patentable over Donohue.

Dependent claims 22 and 44

Claims 22 and 44 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 22 and 44 are also patentable at least by virtue of their dependency.

Furthermore, claims 22 and 44 further recite, *inter alia,* "wherein the main document is referenced to a plurality of insert documents." This feature is not disclosed by Donohue.

The Examiner maintains the position that "Donohue et al. teach the main document referenced to a plurality of insert documents inasmuch as they teach filling a plurality of data fields into one template. (Donohue et al., col. 7, lines 49-55.)" Donohue col. 7, lines 49-55 states:

...a data source 12 storing order and account information for users who purchase items from a merchant operating a web site can include names such as User_Id (storing a unique identifier for each user who registers with the web site), aOrder_Date, aOrder_Id, aTotal_Due, Account_Balance, etc., and values, if any, corresponding to these names...

Thus, Donohue merely discloses a variable correlation system, in which a number of variables (e.g User_Id, aTotal_Due, etc.) are correlated with a value. It appears that the Examiner equates these plurality of variables with Appellants' plurality of insert documents. Appellants submit that one of ordinary skill in the art would not equate a plurality variables with a plurality of documents. For at least this additional reason, Appellants submit that claims 22 and 44 are patentable over Donohue.

Dependent claims 23 and 45

Claims 23 and 45 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 23 and 45 are also patentable at least by virtue of their dependency.

Furthermore, claims 23 and 45 recite, *inter alia,* "wherein the insert document is referenced to a plurality of main documents." This feature is not disclosed by Donohue.

The Examiner's position is that "Donohue et al. teach the insert document referenced to a plurality of main documents inasmuch as Donohue et al. teach a plurality of templates can reference an insert document (Donohue et al., col. 7, lines 16-17.)" (*See* page 6, 4th full paragraph of the Final Office Action). The cited portion of Donohue states: "...and a plurality of document templates."

Appellants submit that this cited portion of Donohue does not support the Examiner's position. Donohue does not disclose the plurality of main documents,

and Donohue does not disclose an insert document referenced to a plurality of main documents. Even if Donohue does disclose a plurality of document templates, the reference does not disclose wherein the insert document is referenced to a plurality of main documents, as set forth in claims 23 and 45. For at least this reason, Appellants respectfully submit that claims 23 and 45 are patentable over Donohue.

Dependent claims 24 and 46

Claims 24 and 46 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 24 and 46 are also patentable at least by virtue of their dependency.

Furthermore, claims 24 and 46 recite, *inter alia*, "wherein the main document is stored separately from the insert document in order to reduce the amount of disk space required to store the main document." This feature is not disclosed by Donohue.

The Examiner apparently has ignored the language "in order to reduce the amount of disk space required to store the main document." Such action is improper. In fact, Donohue does not even address the problem of reducing the amount of disk space. Appellants submit that Donohue does not disclose wherein the main document is stored separately from the insert document in order to reduce the amount of disk space required to store the main document, as set forth in claims 24 and 46.

Furthermore, the portion of Donohue relied on by the Examiner (Donohue col. 7, lines 15-17 and col. 7, lines 36-38) refers to storing a plurality of templates and a data source, but does not disclose storing a main document and an insert document. For at least these reasons, Appellants respectfully submit that claims 24 and 46 are patentable over Donohue.

Dependent claims 25 and 47

Claims 25 and 47 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 25 and 47 are also patentable at least by virtue of their dependency.

Furthermore, claims 25 and 47 recite, *inter alia*, "wherein the main document is stored separately from the insert document in order to enable efficient modification of the insert document that is referenced to multiple main documents." This feature is not disclosed by Donohue.

The Examiner apparently has ignored the language "in order to enable efficient modification of the insert document that is referenced to multiple main documents." Such action is improper. In fact, Donohue does not even address the problem of enabling efficient modification of the insert document that is referenced to multiple main documents. Appellants submit that Donohue does not disclose wherein the main document is stored separately from the insert document in order to enable efficient modification of the insert document that is referenced to multiple main documents, as set forth in claims 25 and 47.

Furthermore, the portion of Donohue relied on by the Examiner (Donohue col. 7, lines 15-17 and col. 7, lines 36-38) refers to storing a plurality of templates and a data source, but does not disclose storing a main document and an insert document. For at least these reasons, Appellants respectfully submit that claims 25 and 47 are patentable over Donohue.

Dependent claims 26 and 48

Claims 26 and 48 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully

submit that claims 26 and 48 are also patentable at least by virtue of their dependency.

Furthermore, claims 26 and 28 recite, *inter alia,* "wherein the insert document is stored in a first database and the main document is stored in a second database." This feature is not disclosed by Donohue.

The Examiner's position is that "Donohue et al. teach storing an insert document in a first database (Donohue et al., col. 7, lines 37-42) and also teach that the main document is stored in a second database inasmuch as they teach storing templates on the web server (Donohue et al., col. 7, lines 15-17) which comprise a database under the broadest reasonable interpretation of the term 'database'" (*See* last paragraph beginning on page 6 of the Final Office Action).

Appellants submit that the portion of Donohue relied on by the Examiner (Donohue col. 7, lines 15-17 and col. 7, lines 37-42) refers to storing a plurality of templates and a data source, but does not disclose storing a main document in a second database and an insert document in a first database. For at least these reasons, Appellants respectfully submit that claims 26 and 48 are patentable over Donohue.

Dependent claims 29, 30, 51, and 52

Claims 29, 30, 51, and 52 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As mentioned above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 29, 30, 51, and 52 are also patentable at least by virtue of their dependency.

Furthermore, claims 29 and 51 recite, *inter alia*, "wherein the main document is a non-HTML document." Similarly, claims 30 and 52 recite, *inter alia*, "wherein the insert document is a non-HTML document." These features are not disclosed by Donohue.

The Examiner relies on the following statement in Donohue (col. 4, lines 5-8) to disclose this feature:

> "The present invention may be applied in the context of any type of networking environment, including internets (including local intemets [sic] and the worldwide Internet) and corporate or organizational intranets."

However, each of the networks mentioned by Donohue uses HTML to represent their information. Appellants submit that Donohue does not disclose wherein the main document and the insert document are non-HTML documents, as set forth in claims 29, 30, 51, and 52. For at least this reason, Appellants respectfully submit that claims 29, 30, 51, and 52 are patentable over Donohue.

Dependent claims 31 and 53

Claims 31 and 53 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As mentioned above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 31 and 53 are also patentable at least by virtue of their dependency.

Furthermore, claims 31 and 53 recite, *inter alia*, "wherein the insert document stored in said first database can be modified to a modified insert document, wherein the modified insert document is inserted into the main document in response to user selecting the main document." This feature is not disclosed by Donohue.

The Examiner maintains the position that "the insert documents taught by Donohue et al. inherently could have been modified to a modified insert document, wherein the modified insert document is inserted into the main document in response to the user selecting the main document." (*See* page 14, lines 3-6 of the Final Office Action).

Such a reliance on inherency is improper. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish

the inherency of that result or characteristic. *In re* Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2D 1955, 1957 (Fed. Cir. 1993). Appellants submit that Donohue does not disclose wherein the insert document stored in said first database can be modified to a modified insert document, wherein the modified insert document is inserted into the main document in response to user selecting the main document, as set forth in claims 31 and 53. For at least this reason, Appellants respectfully submit that claims 31 and 53 are patentable over Donohue.

Dependent claims 33 and 55

Claims 33 and 55 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 33 and 55 are also patentable at least by virtue of their dependency.

Furthermore, claim 33 includes, *inter alia*, the feature "wherein the formula resolution module resolves a formula to a link, said link corresponding to one or more documents, wherein said link is used to identify and retrieve one or more insert documents." Claim 55 includes a similar feature. Donohue fails to disclose this feature.

The Examiner apparently relies on Donohue col. 7, line 64- col. 8, line 8 to disclose this feature. This description has been repeated below for convenience:

> "Using the sample names given above, the data source interface function 20 retrieves from the data source 12 the value of the User_Id based on the identity of the user or client 2, retrieves the names and corresponding values for any other names which are linked to the User_Id name in the data source 1, and stores these name/value pairs in the container. Thus, if the identified user 2 has placed a previous order with the merchant operating the web server 10, the data source interface function 20 retrieves the names and corresponding values of aOrder_Date, aOrder_Id, aTotal_Due, etc. associated with the user 2 and stores those names and values in the container."

Thus it appears as though Donohue is merely correlating values associated with a particular user with a variable (User_Id, aTotal_Due, etc.). The Examiner seems to equate Appellants' one or more insert documents with Donohue's values associated with variables. Appellants submit that an insert document is not the same as a value.

Furthermore, Donohue fails to disclose a formula resolution module. One of ordinary skill would not equate the Appellants' formula with a variable correlation disclosed by Donohue. Therefore, Donohue fails to disclose a formula resolution module that resolves a formula to a link, said link corresponding to one or more documents, wherein said link is used to identify and retrieve one or more insert documents. For at least these reasons, Appellants respectfully submit that claims 33 and 55 are patentable over Donohue.

Dependent claims 34 and 56

Claims 34 and 56 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 34 and 56 are also patentable at least by virtue of their dependency.

Furthermore, claims 34 and 56 recite, *inter alia,* "wherein the formula corresponds to a combination of one or more functions and one or more fields." This feature is not disclosed by Donohue.

The Examiner relies on Donohue col. 8, line 55-col. 9, line 15 to disclose this feature. This description has been repeated, in relevant part, below for convenience:

> The following logic underlies the dynamic tags and flow directives as interpreted by the script 14 and library function 22 in preferred embodiments of the invention: Given a pool P of name/value pairs retrieved from the data source 12 and stored in the container, define

V(name)=the value corresponding to name for all names in P. The dynamic content tag and flow directive logic is then: for a dynamic content tag: @name@ outputs V(name) into the template 24; for an IF instruction in a flow directive: @if condition@X@end@ tests whether condition is TRUE and if so outputs X into the template 24...

Thus, it appears that this portion of Donohue discloses conditions for dynamic tag content flow between name/value pairs. These conditions for dynamic tags are not the same as Appellants' combination of one or more functions and one or more fields. Appellants submit that Donohue does not disclose that the formula corresponds to a combination of one or more functions and one or more fields. For at least this additional reason, Appellants submit that claims 34 and 56 are patentable over Donohue.

Dependent claims 35 and 57

Claims 35 and 57 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 35 and 57 are also patentable at least by virtue of their dependency.

Furthermore, claims 35 and 57 include, *inter alia*, the feature "wherein the formula may be defined based on a function, wherein the function determines a date and generates a link for the determined date." Donohue fails to disclose this feature.

As set forth in the discussion of claims 33 and 55, it appears as though Donohue is merely correlating values associated with a particular user with a variable (User_Id, aTotal_Due, etc.). Donohue discloses using a variable (aOrder_Date) to retrieve different values of dates associated with different users.

Donohue retrieves the real date value and appears to stop there; whereas Appellants further generate a link based on the determined date. Donohue does not disclose generating a link based on the determined date.

Furthermore, Donohue fails to disclose a formula as set forth in Appellants' specification at page 9, lines 3-14. One of ordinary skill would not equate the Appellants' formula with a variable correlation disclosed by Donohue. Therefore, Donohue fails to disclose the formula may be defined based on a function, wherein the function determines a date and generates a link for the determined date. For at least these reasons, Appellants respectfully submit that claims 35 and 57 are patentable over Donohue.

Dependent claims 37 and 59

Claims 37 and 59 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 37 and 59 are also patentable at least by virtue of their dependency.

Furthermore, claim 37 recites, *inter alia,* "a request receiving module that receives a request from a user to open the main document." Claim 59 recites a similar feature. This feature is not disclosed by Donohue.

The Examiner relies on Donohue col. 27-30 to disclose this feature. Donohue col. 27-30 discloses the conventional manner in which a client computer accesses a web page URL. Appellants submit that Donohue's web access is not the same as Appellants' request receiving module. For at least this additional reason, Appellants submit that claims 37 and 59 are patentable over Donohue.

Dependent claims 38 and 60

Claims 38 and 60 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Donohue. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 38 and 60 are also patentable at least by virtue of their dependency.

Furthermore, claim 38 includes, *inter alia*, the feature "wherein the formula resolution module resolves a formula to a link, said link corresponding to one or more documents, wherein said link is used to identify and retrieve one or more insert documents." Claim 60 recites a similar feature. Donohue fails to disclose this feature.

The Examiner apparently relies on Donohue col. 7, lines 49-58 to disclose this feature. As set forth in the discussion of claims 33 and 55, it appears as though Donohue is merely correlating values associated with a particular user with a variable (User_Id, aTotal_Due, etc.). Furthermore, Donohue fails to disclose a formula as set forth in Appellants' specification at page 9, lines 3-14. One of ordinary skill would not equate the Appellants' formula with a variable correlation disclosed by Donohue. Donohue also fails to disclose that the reference is a link. Therefore, Donohue fails to disclose the reference is a link, wherein said link is other than the formula. For at least these reasons, Appellants respectfully submit that claims 38 and 60 are patentable over Donohue.

5. Rejections Under 35 U.S.C. §103(a) Donohue in view of Appleman-

Requirements for a prima facie case of obviousness

As stated in the MPEP § 2143, three requirements must be met to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). The requirements are: (1) the prior art must teach or suggest all the claim

elements, (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings, and (3) there must be a reasonable expectation of success.

Appellants respectfully submit that at least the first two requirements are not met by the asserted rejection. Therefore, Appellants examine those requirements in further detail.

All of the claim elements must be taught or suggested

To establish *prima facie* obviousness of a claimed invention, all the claim elements must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Suggestion or Motivation to modify the references

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Dependent claims 3, 8, 12, and 15

Claims 3, 8, 12, and 15 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Donohue in view of Appleman. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 3, 8, 12, and 15 are also patentable at least by virtue of their dependency.

Claim 3 recites, *inter alia,* "wherein the system also enables a user to create and store a main document having a reference to an insert document; and wherein the document destination module enables a user to create a main document with a reference to an insert document and stores the main document with the reference separate from the insert document being referenced." Claims 8, 12, and 15 recite similar features.

The Examiner acknowledges that "Donohue et al. do not teach enabling a user to create the main document with the reference to the insert document and storing the main document with references separately from the insert document being referenced." (*See* page 8, paragraph number 11 of the Final Office Action).

The Examiner relies on Appleman to teach this feature. However, Apellants submit that there is no legally proper suggestion to combine Donohue and Appleman. The Examiner maintains the position that:

> "Appleman et al. would have motivated one of ordinary skill in the art to take this step inasmuch as they teach that their approach eliminates or reduces the *need to hard code* design elements in a web page, promoting greater 'greater design and maintenance flexibility.' (Appleman., col. 9, lines 22-41). Therefore, it would have been obvious...." (See page 8, paragraph number 11 of the Final Office Action). (*Emphasis added*).

Donohue does not use hard coding of design elements, because Donohue is directed to dynamic tags corresponding to data values that populate HTML templates. Thus, Donohue achieves "maintenance flexibility" by using dynamic content tags for embedding HTML data. Appellants submit that the Examiner's alleged motivation to combine Appleman with Donohue improper, because Donohue does not suffer from the drawbacks suggested by the Examiner.

Appellants submit that neither Donohue, nor Appleman, set forth any teaching, suggestion, or motivation to combine the two references. Further, Appellants contend that no motivation or suggestion to combine Donohue or Appleman may be found in the knowledge generally available to those skilled in

the art.   At least for this additional reason, Appellants submit that claims 3, 8, 12,
and 15 are patentable over Donohue and Appleman.

6. <u>Rejections Under 35 U.S.C. §103(a) Donohue and Appleman in view
of Poole</u> -

Dependent claims 4, 9, and 13

Claims 4, 9, and 13, stand rejected under 35 U.S.C. §103(a) as allegedly
being unpatentable over Donohue and Appleman in view of Poole. As set forth
above, Donohue fails to disclose each of the features in the independent claims
and thus, necessarily fails to disclose the features of the dependent claims.
Donohue and Appleman also fail to teach or suggest the features of claims 3, 8,
and 12 and thus, necessarily fail to disclose the features of claims 4, 9, and 13.
Therefore, Appellants respectfully submit that claims 4, 9, and 13 are also
patentable at least by virtue of their dependency.

Furthermore, claim 4 includes, *inter alia*, the feature of "a formula
definition module that enables a user to define a formula that resolves to a
reference to an insert document to be included in the main document." Claims 9
and 13 recite similar features. Donohue, Appleman, and Poole, both alone and
in combination fail to teach or suggest these features.

The Examiner concedes that "Neither Donohue et al. nor Appleman et al.
teaches enabling a user to define the formula that resolves to the reference to
the insert document to be included in the main document", and relies on Poole
col. 5, lines 7-10 to teach this feature (*See* page 9, paragraph number 12 of the
Final Office Action). The cited portion of Poole states:

> Each of the constituent portions of the document is associated with an
> entity reference, which is selected by the document developer as indicated
> at step 34.

The portion below in col. 5, lines 48-50 of Poole states:

A comparison is made between the name of the entity reference to be resolved and the entity identifiers contained in the Catalogue 26.

Thus it appears as though Poole is correlating an entity reference with a constituent portion/entity. Appellants submit that Poole merely discloses using a reference to a constituent portion, but does not teach or suggest a "formula that resolves to a reference to an insert document." Rather, Poole's resolution process involves a comparison between the entity reference and the entity in a catalog. Accordingly, Donohue and Appleman in view of Poole do not teach or suggest a formula that resolves to a reference, as set forth in claim 4. For at least this reason, Appellants respectfully submit that claims 4, 9, and 13 are patentable over Donohue and Appleman in view of Poole.

Furthermore, there is no legally proper suggestion to combine Donohue, Appleman and Poole. Appellants submit that the combination of Donohue, Appleman, and Poole constitutes impermissible hindsight. In combining Donohue, Appleman with Poole, the Examiner alleges that:

> "[O]ne of ordinary skill in the art would have recognized that the user would have needed the ability to define the formula that resolves to the reference to the insert document to be included in the main document in order to ensure that the appropriate insert document was inserted." (See page 9, paragraph number 12 of the Final Office Action).

Appellants submit that the Examiner's recited motivation for combining Donohue, Appleman, and Poole merely constitutes a restatement of at least one of the objects of the invention as set forth by the Appellants in the Specification:

> "Formula definition module 52 may include a module that enables a user, in step 304, to define a formula for dynamically determining which of a plurality of insert documents to include in the main document. Formula definition module may include a graphical user interface through which the user may input a formula..." (See specification page 10, lines 18-22).

As such, the combination is improper. As stated in *In re Vaeck*, "the teaching or suggestion to make the claimed combination ... must ... be found in

the prior art, not in Applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

Even if Donohue, Appleman, and Poole may be properly combined, there is nothing in the combination of references that suggests using the specific combination of elements claimed; to selectively pick and choose among the many disclosed elements constitutes impermissible hindsight.

For at least the reason that there is no legally proper suggestion to combine Donohue, Appleman, and Poole, and because Appellants have shown that, but for their disclosure, one of ordinary skill in the art would not have been motivated to combine Donohue, Appleman, and Poole, Appellants submit that the rejection of dependent claims 4, 9, and 13 is improper and must be withdrawn.

7. Rejections Under 35 U.S.C. §103(a) Donohue in view of HTML 3.2 and Appleman-

Dependent claims 32 and 54

Claims 32 and 54 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Donohue in view of HTML 3.2 and Appleman. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 32 and 54 are also patentable at least by virtue of their dependency.

Furthermore, claims 32 and 54 recite, *inter alia,* "wherein the main document includes a pre-defined portion, said pre-defined portion may be specified to include an insert document." This feature is not taught or suggested by Donohue. In one embodiment, the main document may include a table having cells with data entries. It may be desirable to have a background for that particular cell have an image, picture, or sound related to the date presented in the cell. For example, for a date in the month of January, a snow background may be appropriate. (See specification page 15, lines 1-5).

The Examiner acknowledges that Donohue does "not teach that the predefined portion may be specified to include an insert document representing a background for the main document." (See page 10, 1st full paragraph of the Final Office Action).

The Examiner relies on HTML 3.2 to teach this feature. However, HTML 3.2 fails to teach or suggest this feature, because HTML 3.2 does not teach or suggest a pre-defined portion of a main document. The section of HTML 3.2 relied upon by the Examiner merely discloses a main HTML page with an attribute set to tile the background of the main HTML page with a selected image. Appellants submit that the main HTML page does not include a pre-defined portion as recited by Appellants' claim. Rather, the attribute selects an image and covers the background of the HTML page with copies of the image of a certain tile size. Appellants submit that covering the background of a main document with copies of an image of a certain image tile size is not the same as Appellants' wherein the main document includes a pre-defined portion, said pre-defined portion may be specified to include an insert document. Thus, HTML 3.2 does not teach or suggest the main document includes a pre-defined portion. For at least at least this additional reason, Appellants submit that claims 32 and 54 are patentable over Donohue, HTML 3.2, and Appleman.

Furthermore, there is no legally proper suggestion to combine Donohue, with Appleman and HTML 3.2.

The Examiner maintains that:

"Appleman et al. would have provided motivation to one of ordinary skill in the art to make the predefined portion specified to include an insert document representing a background for the main document Appleman et al. teaches the benefits of being able to soft-code design elements (Appleman et al., col. 9, lines 22-41), and one of ordinary skill in the art would have recognized that background is a design element..." (See page 10, 1st full paragraph of the Final Office Action).

Appellants submit that Appleman does not provide motivation to combine HTML 3.2 with Donohue. As set forth above, the alleged motivation for

combining Appleman with Donohue does not exist, because Donohue does not suffer from the drawbacks associated with the need for "hard coding" relied upon by the Examiner. Further, HTML 3.2 does not disclose "soft-coding" the background image to an HTML web page. HTML 3.2 discloses that the background attribute specifies a URL for an image that will be used to tile a background. Appellants submit that using a URL to address a background image in the traditional manner is "hard-coding" a design element. Because the Examiner relies on Appleman's statement on the drawbacks of "hard-coding", Appleman does not provide motivation for combining HTML 3.2 (hard code) with Donohue. Therefore, the combination of HTML 3.2 with Donohue is improper. For at least at least this additional reason, Appellants submit that claims 32 and 54 are patentable over Donohue, HTML 3.2, and Appleman.

8. Rejections Under 35 U.S.C. §103(a) Donohue in view of Poole -

Dependent claim 16

Claim 16 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Donohue in view of Poole. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claim 16 is also patentable at least by virtue of its dependency.

Furthermore, claim 16 includes, *inter alia*, the feature of "computer readable program code means for causing a computer to enable a user to define a formula that resolves to a reference to an insert document to be included in the main document." Donohue and Poole, both alone and in combination fail to teach or suggest this feature.

The Examiner concedes that "Donohue et al. do not teach enabling a user to define the formula that resolves to the reference to the insert document to be included in the main document", and relies on Poole col. 5, lines 7-10 to teach

this feature (*See* page 9, paragraph number 12 of the Final Office Action). The cited part of Poole states:

> Each of the constituent portions of the document is associated with an entity reference, which is selected by the document developer as indicated at step 34.

The portion below in col. 5, lines 48-50 of Poole states:

> A comparison is made between the name of the entity reference to be resolved and the entity identifiers contained in the Catalogue 26.

As set forth above, it appears as though Poole is correlating an entity reference with a constituent portion/entity. Appellants submit that Poole merely discloses using a reference to a constituent portion, but does not teach or suggest a "formula that resolves to a reference to an insert document." Rather, Poole's resolution process involves a comparison between the entity reference and the entity in a catalog. Accordingly, Donohue in view of Poole does not teach or suggest a formula that resolves to a reference, as set forth in claim 16. For at least this reason, Appellants respectfully submit that claim 16 is patentable over Donohue in view of Poole.

Furthermore, there is no legally proper suggestion to combine Donohue with Poole. Appellants submit that the combination of Donohue and Poole constitutes impermissible hindsight. In combining Donohue with Poole, the Examiner alleges that: "one of ordinary skill in the art would have recognized that the user would have needed the ability to define the formula that resolves to the reference to the insert document to be included in the main document in order to ensure that the appropriate insert document was inserted." (See page 11, 1st full paragraph of the Final Office Action).

Appellants submit that the Examiner's recited motivation for combining Donohue with Poole merely constitutes a restatement of at least one of the objects of the invention as set forth by the Appellants in the Specification:

> "Formula definition module 52 may include a module that enables a user, in step 304, to define a formula for dynamically determining which of a

plurality of insert documents to include in the main document. Formula definition module may comprise a graphical user interface through which the user may input a formula..." (See specification page 10, lines 18-22).

As such, the combination is improper. As stated in *In re Vaeck*, "the teaching or suggestion to make the claimed combination ... must ... be found in the prior art, not in Applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

Even if Donohue and Poole may be properly combined, there is nothing in the combination of references that suggests using the specific combination of elements claimed; to selectively pick and choose among the many disclosed elements constitutes impermissible hindsight.

For at least the reason that there is no legally proper suggestion to combine Donohue with Poole, and because Appellants have shown that, but for their disclosure, one of ordinary skill in the art would not have been motivated to combine Donohue with Poole, Appellants submit that the rejection of dependent claim 16 is improper and must be withdrawn.

9. **Rejections Under 35 U.S.C. §103(a) Donohue in view of Crow** -

Independent claim 61

Appellants respectfully submit that the rejection of claims 61 as allegedly being unpatentable under 35 U.S.C. §103(a) over Donohue in view of Crow is improper for at least failing to teach or suggest all the claim elements.

Claim 61 includes, *inter alia*, the features of "inserting said identified insert document into said main document at a pre-determined document location point." At least these features are not taught or suggested by Donohue and Crow.

Apparently, the Examiner relies on the descriptions in Donohue that disclose inserting stored textual contents such as name, user-ID, order-ID, total-due, etc., into a web-based template using dynamic HTML content tags. This description has been reproduced below for convenience:

...into the markup language document dynamic flow directives comprising one or more second control symbols, one or more if or loop instructions...

Alternatively, the data source 12 may be stored on another computer to which the web server 10 has access. In some embodiments, the data source is a relational database and includes a database storing content to be inserted into the templates 24...

For a dynamic tag, the template user 18 calls the appropriate library function 22 to retrieve the value corresponding to the name in the tag from the container, step 62, and replace the dynamic tag, including the name and control symbols, with the value retrieved from the container, step 64.... (*See* col. 6, lines 10-13, col. 7, lines 37-41, and col. 10, lines 60-65 of Donohue).

Donohue apparently discloses inserting stored textual contents such as name, user-ID, order-ID, total-due, etc., into a web-based template using dynamic HTML content tags. Inserting textual data is not the same as inserting a document that includes the data. The Examiner asserts that the specification broadly defines "insert document," stating that term "should be understood to include data that may inserted into a main document," and therefore the data falls within the definition of "insert document" (*See* page 14, lines 14-16 of the Final Office Action). This interpretation of insert document by the Examiner is improper because the insert document is not data *per se*. The specification indicates that the insert document includes data (*See* specification, page 7, lines 4-5). A document that includes data is not the same as data itself. Accordingly, Donohue does not disclose inserting said identified insert document into said main document as set forth in claim 61.

In addition, claim 61 includes, *inter alia*, the feature of "continuously resolving the formula" and "modifying said identified insert document that is inserted in the main document based on the continuously resolved formula." At least this feature is not taught or suggested by Donohue or Crow, alone or in combination with one another. In one embodiment, document retrieval module and document insertion module change the insert document that is inserted in an open main document. Formula resolution module may therefore provide for a

scrolling effect of images within a main document, for example. (See specification page 17, lines 20-23).

The Examiner acknowledges that "Donohue et al. do not teach resolving the formula continuously." (See page 13, first full paragraph of the Final Office Action). The Examiner relies on Crow col. 4, lines 52-55 to teach this feature. This passage of Crow has been repeated below for convenience:

> In a preferred embodiment, those web objects 114 maintained in the cache 110 are periodically refreshed, so as to assure those web objects 114 are not "stale" (changed at the server but not at the cache).
> (See col. 2, lines 42-45 and col. 4, lines 52-55 of Crow).

Thus, Crow apparently discloses refreshing a web object stored in a cache. However, this not the same as modifying said identified insert document that is inserted in the main document based on the continuously resolved formula, as set forth in claim 61. For at least the foregoing reasons, Appellants respectfully submit that claim 61 is patentable over Donohue and Crow, both alone and in combination.

Appellants submit that neither Donohue, nor Crow, set forth any teaching, suggestion, or motivation to combine the two references. Donohue is directed toward solving the problem of producing and delivering documents having embedded dynamic content. (See Donohue, col. 1, lines 15-17). Crow is concerned with reducing latency in reviewing and presenting web documents. (See Crow col. 2, lines 21-23). Further, Appellants contend that no motivation or suggestion to combine Donohue or Crow may be found in the knowledge generally available to those skilled in the art.

Even if Crow was combinable with Donohue, the combination remains deficient, because Donohue and Crow do not teach or suggest inserting said identified insert document into said main document at a pre-determined document location point, continuously resolving the formula, and modifying said identified insert document that is inserted in the main document based on the continuously resolved formula. Appellants respectfully submit that claim 61 is patentable over Donohue and Crow

Dependent claims 17 and 39

Claims 17 and 39 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Donohue in view of Crow. As set forth above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 17 and 39 are also patentable at least by virtue of their dependency.

Furthermore, claim 17 includes, *inter alia*, the feature of a "continuous resolving module that resolves the formula continuously in order to modify the insert document that is inserted in an opened main document." Claim 39 includes a similar feature. In an exemplary embodiment, formula resolution module 54 may continuously resolve the formula and if a different output is determined, may change the insert document that is inserted in an open main document. Formula resolution module 54 may therefore provide for scrolling effect of images within a main document. (*See* specification, page 17, lines 17-23).

The Examiner concedes that "Donohue et al. do not teach a continuous resolving module that resolves the formula continuously", and relies on Crow col. 4, lines 52-55 to teach this feature (*See* paragraph 15, page 11 of the Final Office Action).

The cited portion on which the Examiner relies states:

In a preferred embodiment, those web objects 114 maintained in the cache 110 are periodically refreshed, so as to assure those web objects 114 are not "stale" (changed at the server but not at the cache).
(*See* col. 2, lines 42-45 and col. 4, lines 52-55 of Crow).

Appellants respectfully submit that one of ordinary skill would not equate Crow's refreshing of objects stored in cache memory with Appellants' continuous resolving module that resolves the formula continuously in order to modify the insert document that is inserted in an opened main document set forth in claims

17 and 39. For at least this reason, Appellants respectfully submit that claims 17 and 39 are patentable over Donohue and Crow.

Appellants submit that neither Donohue, nor Crow, set forth any teaching, suggestion, or motivation to combine the two references. Donohue is directed toward solving the problem of producing and delivering documents having embedded dynamic content. (See Donohue, col. 1, lines 15-17). Crow is more concerned with reducing latency in reviewing and presenting web documents. (See Crow col. 2, lines 21-23). Further, Appellants contend that no motivation or suggestion to combine Donohue or Crow may be found in the knowledge generally available to those skilled in the art. At least for this additional reason, Appellants submit that claims 17 and 39 are patentable over Donohue and Crow.

Dependent claims 36 and 58

Claims 36 and 58 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Donohue in view of Crow. As mentioned above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 36 and 58 are also patentable at least by virtue of their dependency.

Furthermore, claims 36 and 58 include, *inter alia*, the feature of "wherein the link is continuously resolved to a field representing an image for the main document." In an exemplary embodiment, formula resolution module 54 may continuously resolve the formula and if a different output is determined, may change the insert document that is inserted in an open main document. Formula resolution module 54 may therefore provide for scrolling effect of images within a main document. (*See* specification, page 17, lines 17-23).

The Examiner concedes that "Donohue et al. does not teach a continuously resolving link to a field representing an image for the main document", and relies on Crow col. 3, lines 53-53 and col. 4, lines 52-55 to teach this feature. However, as set forth in the discussion of claims 17 and 39, Crow

merely discloses periodic refreshment of web documents stored in cache to assure those web documents are not "stale" (changed at the server but not at the cache). (*See* Crow col. 2, lines 42-45 and col. 4, lines 52-55). Appellants respectfully submit that one of ordinary skill would not equate Crow's refreshing of objects stored in cache memory with Appellants' link being continuously resolved to a field representing an image for the main document set forth in claims 36 and 58.

Accordingly, Donohue and Crow, both alone and in combination, do not teach or suggest the link is continuously resolved to a field representing an image for the main document, as set forth in claims 36 and 58. For at least this reason, Appellants respectfully submit that claims 36 and 58 are patentable over Donohue and Crow.

Appellants submit that neither Donohue, nor Crow, set forth any teaching, suggestion, or motivation to combine the two references. The Examiner maintains that "one of ordinary skill in the art would have recognized the benefit of having the most up-to-date data, including the most up-to-date images, possible." (*See* page 12, top paragraph of Final Office Action). However, Donohue is not about images that should be updated. Donohue is concerned with dynamic tags representing data values for embedded dynamic content. Therefore, there would be no legally proper suggestion or motivation to combine a reference disclosing refreshing images with Donohue's system for delivering documents using embedded non-image dynamic content.

Furthermore, Donohue is directed toward solving the problem of producing and delivering documents having embedded dynamic content. (*See* Donohue, col. 1, lines 15-17). Crow is more concerned with reducing latency in reviewing and presenting web documents. (*See* Crow col. 2, lines 21-23). Appellants contend that no motivation or suggestion to combine Donohue or Crow may be found in the knowledge generally available to those skilled in the art. At least for this additional reason, Appellants submit that claims 36 and 58 are patentable over Donohue and Crow, both alone and in combination.

10. **Rejections Under 35 U.S.C. §103(a) Donohue in view of Richards** -

Dependent claims 27, 28, 49, and 50

Claims 27 and 49 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Donohue in view of Richards. As mentioned above, Donohue fails to disclose each of the features in the independent claims and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellants respectfully submit that claims 27, 28, 49, and 50 are also patentable at least by virtue of their dependency.

Dependent claims 26 and 48 recite "wherein the insert document is stored in a first database and the main document is stored in a second database." Furthermore, claims 27 and 49 the additional features "wherein the first database is a LotusNotes database." Similarly, claims 28 and 50 recite, *inter alia*, "wherein the second database is a LotusNotes database." These features are not taught or suggested by Donohue or Richards.

The Examiner acknowledges, "Donohue et al. do not teach that either the first database or the second database is a Lotus Notes database." (*See* page 13, paragraph 16 of the Final Office Action). However, the Examiner maintains that "Richards would have provided motivation for one of ordinary skill in the art to make the first and second databases Lotus Notes databases inasmuch as Richards teaches on page 9 the Lotus Notes databases were easy to develop." (*See* page 13, paragraph number 16, of the Final Office Action).

The rejection of claims 27, 28, 49, and 50 is improper as there exists no teaching, suggestion, or motivation to modify Donohue to include the teachings of Richards. Richards simply discloses a Lotus Notes database. Appellants submit that there would have been no motivation to combine a Lotus Notes database, in particular, with the method and system for producing and delivering documents having embedded dynamic content of Donohue. For at least this reason, Appellants respectfully submit that claims 27, 28, 49, and 50 are patentable over Donohue and Richards.
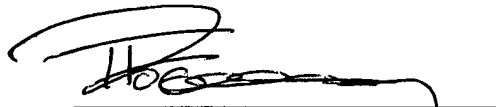
Conclusion

Because the references relied upon by the Examiner, either alone or in combination with one another, fail to disclose, teach or suggest all of the features of the claims as set forth above, Appellants respectfully request that the rejection of each of pending claims 1-61 under 35 U.S.C. §112, 35 U.S.C. §102, and/or 35 U.S.C. §103 be reversed.

Dated: February 23, 2004   Respectfully submitted,

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APPENDIX A – PENDING CLAIMS

LISTING OF CLAIMS:

1.   (*Previously Presented*) A system for retrieving a main document with a reference to an insert document for inclusion in the main document comprising:

a data storage mechanism that stores the main document with a formula that resolves to a reference to an insert document, the insert document including contents for the main document;

a shared resource database, accessible by a plurality of clients of the system, that stores one or more insert documents that may be referenced within a main document;

a document destination module that opens the main document and extracts the formula;

a formula resolution module that resolves the formula to derive a value for the reference;

a document retrieval module that uses the reference to retrieve the insert document; and

a document insertion module that inserts the insert document into the main document in a document location point specified.

2.   (*Original*) The system of claim 1 further comprising:

a document identification module that receives a reference and determines the name of the insert document to be retrieved based on the reference.

3.   (*Original*) The system of claim 1 wherein the system also enables a user to create and store a main document having a reference to an insert document; and wherein the document destination module enables a user to

create a main document with a reference to an insert document and stores the main document with the reference separate from the insert document being referenced.

4.   (*Original*) The system of claim 3 further comprising a formula definition module that enables a user to define a formula that resolves to a reference to an insert document to be included in the main document.

5.   (*Original*) The system of claim 1 wherein the document location point comprises a background in the main document.

6.   (*Previously Presented*) A system for retrieving a main document with a reference to an insert document for inclusion in the main document comprising:

data storage means for storing the main document with a formula that resolves to a reference to an insert document, the insert document including contents for the main document;

database means for storing one or more insert documents that may be referenced within a main document;

formula resolution means for resolving the formula to derive a value for the reference;

means for retrieving and opening a main document;

document retrieval means for retrieving the insert document using the reference; and

document insertion means for inserting the insert document into the main document at a document insertion point.

7.   (*Original*) The system of claim 6 further comprising:

document identification means for receiving a reference and determining the name of the insert document to be retrieved based on the reference.

8.   (*Original*) The system of claim 6 wherein the system also enables a user to create and store a main document having a reference to an insert document; and

wherein the document destination means comprises means for enabling a user to create a main document with a reference to an insert document and means for storing the main document with the reference separate from the insert document being referenced.

9.   (*Original*) The system of claim 8 further comprising formula definition means for enabling a user to define a formula that resolves to a reference to an insert document to be included in the main document.

10.   (*Original*) The system of claim 6 wherein the document location point comprises a background in the main document.

11.   (*Previously Presented*) A method for managing a main document with one or more insert documents inserted therein comprising the steps of:

storing the main document with a formula that resolves to a reference to an insert document, the insert document including contents for the main document;

storing one or more insert documents that may be referenced within a main document;

retrieving and opening a main document;

extracting the formula from the main document;

resolving the formula to the reference to an insert document based on the main document;

retrieving the insert document; and

inserting the insert document into the main document at a document location point.

12.   (*Original*) The method of claim 11 further comprising the steps of:

creating a main document with a reference to an insert document to be included in the main document; and

storing the main document having a reference to an insert document separate from the insert document included in the stored main document.

13.   (*Original*) The method of claim 12 further comprising the step of enabling a user to define a formula that resolves to a reference to an insert document to be included in the main document.

14.   (*Previously Presented*) A computer usable medium having computer readable program code means embodied therein for managing a main document with a reference to one or more insert documents to be included in the main document comprising:

computer readable program code means for causing a computer to store the main document with a formula that resolves to a reference to an insert document, the insert document including contents for the main document;

computer readable program code means for causing a computer to store one or more insert documents that may be referenced within a main document;

computer readable program code means for causing a computer to extract a formula from the main document;

computer readable program code means for causing a computer to resolve the formula to a reference to an insert document from the main document;

computer readable program code means for causing a computer to retrieve the insert document; and

computer readable program code means for causing a computer to insert the insert document into the main document.

15.   (*Original*) The computer readable medium of claim 14 further comprising:

computer readable program code means for causing a computer to create a main document with a reference to an insert document to be included in the main document; and

computer readable program code means for causing a computer to store the main document having a reference to an insert document without the insert document included in the stored main document.

16.   (*Original*) The computer readable medium of claim 14 further comprising computer readable program code means for causing a computer to enable a user to define a formula that resolves to a reference to an insert document to be included in the main document.

17.   (*Previously Presented*) The system of claim 1, further comprising a continuous resolving module that resolves the formula continuously in order to modify the insert document that is inserted in an opened main document.

18.   (*Previously Presented*) The system of claim 17, wherein the formula is resolved continuously according to an occurrence of an event.

19.   (*Previously Presented*) The system of claim 18, wherein the event includes a predetermined period of time.

20.   (*Previously Presented*) The system of claim 18, wherein the event includes an input from a user.

21.   (*Previously Presented*) The system of claim 18, wherein the event is programmable using a scripting language.

22.   *(Previously Presented)* The system of claim 1, wherein the main document is referenced to a plurality of insert documents.

23.   *(Previously Presented)* The system of claim 1, wherein the insert document is referenced to a plurality of main documents.

24.   *(Previously Presented)* The system of claim 1, wherein the main document is stored separately from the insert document in order to reduce the amount of disk space required to store the main document.

25.   *(Previously Presented)* The system of claim 1, wherein the main document is stored separately from the insert document in order to enable efficient modification of the insert document that is referenced to multiple main documents.

26.   *(Previously Presented)* The system of claim 1, wherein the insert document is stored in a first database and the main document is stored in a second database.

27.   *(Previously Presented)* The system of claim 26, wherein the first database is a LotusNotes database.

28.   *(Previously Presented)* The system of claim 26, wherein the second database is a LotusNotes database.

29.   *(Previously Presented)* The system of claim 1, wherein the main document is a non-HTML document.

30.   *(Previously Presented)* The system of claim 1, wherein the insert document is a non-HTML document.

31.   (*Previously Presented*) The system of claim 26, wherein the insert document stored in said first database can be modified to a modified insert document, wherein the modified insert document is inserted into the main document in response to user selecting the main document.

32.   (*Previously Presented*) The system of claim 1, wherein the main document includes a pre-defined portion, said pre-defined portion may be specified to include an insert document representing a background for the main document.

33.   (*Previously Presented*) The system of claim 1, wherein the formula resolution module resolves a formula to a link, said link corresponding to one or more documents, wherein said link is used to identify and retrieve one or more insert documents.

34.   (*Not Entered*) The system of claim 1, wherein the formula corresponds to a combination of one or more functions and one or more fields.

35.   (*Previously Presented*) The system of claim 1, wherein the formula may be defined based on a function, wherein the function determines a date and generates a link for the determined date.

36.   (*Previously Presented*) The system of claim 35, wherein the link is continuously resolved to a field representing an image for the main document.

37.   (*Previously Presented*) The system of claim 1, further comprising a request receiving module that receives a request from a user to open the main document.

38.   (*Previously Presented*) The system of claim 1, wherein the reference is a link, wherein said link is other than the formula.

39.   (*Previously Presented*) The method of claim 11, wherein the step of resolving includes continuously resolving the formula in order to modify the insert document that is inserted in an opened main document.

40.   (*Previously Presented*) The method of claim 39, wherein the formula is resolved continuously according to an occurrence of an event.

41.   (*Previously Presented*) The method of claim 40, wherein the event includes a predetermined period of time.

42.   (*Previously Presented*) The method of claim 40, wherein the event includes an input from a user.

43.   (*Previously Presented*) The method of claim 40, wherein the event is programmable using a scripting language.

44.   (*Previously Presented*) The method of claim 11, wherein the main document is referenced to a plurality of insert documents.

45.   (*Previously Presented*) The method of claim 11, wherein the insert document is referenced to a plurality of main documents.

46.   (*Previously Presented*) The method of claim 11, wherein the main document is stored separately from the insert document in order to reduce the amount of disk space required to store the main document.

47.   (*Previously Presented*) The method of claim 11, wherein the main document is stored separately from the insert document in order to enable efficient modification of the insert document that is referenced to multiple main documents.

48.   (*Previously Presented*) The method of claim 11, wherein the insert document is stored in a first database and the main document is stored in a second database.

49.   (*Previously Presented*) The method of claim 48, wherein the first database is a LotusNotes database.

50.   (*Previously Presented*) The method of claim 48, wherein the second database is a LotusNotes database.

51.   (*Previously Presented*) The method of claim 11, wherein the main document is a non-HTML document.

52.   (*Previously Presented*) The method of claim 11, wherein the insert document is a non-HTML document.

53.   (*Previously Presented*) The method of claim 48, wherein the insert document stored in said first database can be modified to a modified insert document, wherein the modified insert document is inserted into the main document in response to user selecting the main document.

54.   (*Previously Presented*) The method of claim 11, wherein the main document includes a pre-defined portion, said pre-defined portion may be specified to include an insert document representing a background for the main document.

55.   (*Previously Presented*) The method of claim 11, wherein the formula resolution module resolves a formula to a link, said link corresponding to one or more documents, wherein said link is used to identify and retrieve one or more insert documents.

56.   (*Not Entered*) The method of claim 11, wherein the formula corresponds to a combination of one or more functions and one or more fields.

57.   (*Previously Presented*) The method of claim 11, wherein the formula may be defined based on a function, wherein the function determines a date and generates a link for the determined date.

58.   (*Previously Presented*) The method of claim 57, wherein the link is continuously resolved to a field representing an image for the main document.

59.   (*Previously Presented*) The method of claim 11, further comprising receiving a request from a user to open the main document.

60.   (*Previously Presented*) The method of claim 11, wherein the reference is a link, wherein said link is other than the formula.

61.   (*Not Entered*) A method for managing a main document with one or more insert documents inserted therein, the method comprising:
        enabling a user to open said main document, said main document stored in a first database, said main document including a formula corresponding to one or more insert documents stored in a second database;
        resolving the formula: [in order to identify]

identifying at least one corresponding insert document based on the resolved formula, said at least one corresponding insert document including contents for said main document;

retrieving said identified insert document from the second database;

inserting said identified insert document into said main document at a pre-determined document location point; and

continuously resolving the formula; [continuously in order to modify]

modifying said identified insert document that is inserted in the main document based on the continuously resolved formula.

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